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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,538	03/07/2002	Deb K. Chatterjee	IVGN 300	8240
65482	7590	05/03/2007		
INVITROGEN CORPORATION C/O INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER PROUTY, REBECCA E	
			ART UNIT	PAPER NUMBER
			1652	
			MAIL DATE	DELIVERY MODE
			05/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,538	<b>Applicant(s)</b> CHATTERJEE ET AL.	
	<b>Examiner</b> Rebecca E. Prouty	<b>Art Unit</b> 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-26, 28, 30-34, 36, 37, 41-55, 57, 60-87 and 91-96 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 16, 17, 28, 30, 41, 51-55, 57, 60-62, 69, 70, 77, 78, 85-87, and 91-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2-4,6-15,18-26,31-34,36,37,43-50,63-68,71-76 and 79-84.

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Claims 5, 27, 29, 35, 38-40, 42, 56, 58, 59, and 88-90 have been canceled. Claims 1-4, 6-26, 28, 30-34, 36, 37, 41-55, 57, 60-87 and 91-96 are still at issue and are present for examination.

Claims 2-4, 6-15, 18-26, 31-34, 36, 37, 43-50, 63-68, 71-76 and 79-84 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the replies filed on 10/4/04 and 8/2/06. Therefore, claims 1, 16, 17, 28, 30, 41, 51-55, 57, 60-62, 69, 70, 77, 78, 85-87, and 91-96 are examined herein.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1, 16, 17, 28, 30, 41, 51-55, 57, 60, 85, 91, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt (1984) in view of Yu et al. (Reference AR14 of applicant's IDS). The rejection is explained in the previous Office Action.

Applicants argue that neither Pratt nor Yu et al. disclose ITT extracts in which the extract is modified by the addition of Gam protein. Applicants argue that Yu et al. do not teach inhibition of a nuclease by addition of a protein to the cell extract but rather, Yu et al. teach expression of the Gam gene within cells that also express RecBC nuclease. However, this is not persuasive as applicants are arguing distinctions in the method of preparation of the claimed extract and not a distinction in the extract itself. Applicants are reminded that their claims recite products and not a process of making the product. Patentability of a product claim including product claims written in product-by-process format is determined by the characteristics of the product itself not by its method of making. There would be no distinction between a cell extract made by transforming a cell with a heterologous gene, culturing the cell so as to express the gene and making an extract and an extract made by culturing an otherwise similar cell which is not transformed, making a cell extract and then adding an amount of

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the same protein produced by the heterologous gene to the cell extract. The product produced is identical, i.e., a cell extract including an amount of a heterologous protein not otherwise produced by the cell from which the extract was made.

Applicants further argue that one of ordinary skill in the art would not have a reasonable expectation of success in producing an in vitro synthesis system by adding Gam protein to an *E. coli* extract to produce an in vitro synthesis system as at the time the invention was made, it was not known whether addition of Gam protein to an *E. coli* cell extract would protect linear DNA molecules from degradation, if the use of Gam protein in an in vitro synthesis system would adequately reduce or eliminate recBC activity, or whether it would interfere with transcription and/or translation. However, Yu et al. clearly demonstrate that the addition of Gam was successful to inhibit the degradation of linear DNAs in the recombination system Yu et al. was utilizing such that a skilled artisan would expect it to function similarly in an ITT system as both are systems include the entire cellular mix of *E. coli* proteins and applicants have advanced no reason for a skilled artisan to believe that addition of the Gam protein (whether by exogenous addition or by expression in the cell prior to preparation of the extract) would interfere with transcription and/or translation. Since

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the function of the Gam protein is to inhibit the RecBCD nuclease which is a protein not known to be involved in the processes of transcription and translation, a skilled artisan would not expect addition of Gam to be detrimental to these processes. Applicants are reminded that obviousness does not require an absolute certainty of success, but only a reasonable expectation thereof.

Claims 86, 87, 92, 93, 95, and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt (1984) in view of Yu et al. (Reference AR14 of applicant's IDS) as applied to claims 1, 16, 17, 28, 30, 41, 51-55, 57, 60, 85, 91, and 94 above, and further in view of Swartz et al. (WO 00/55353). The rejection is explained in the previous Office Action.

Applicant has not presented any arguments specifically traversing this rejection but instead relies upon the traversal discussed above. Therefore, this rejection is maintained for the reasons presented above.

Claims 61, 62, 69, 70, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt (1984) in view of Yu et al. (Reference AR14 of applicant's IDS) as applied to claims 1, 16, 17, 28, 30, 41, 51-55, 57, 60, 85, 91, and 94 above, and further in view of Kudlicki et al. (US Patent

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6664,379. The rejection is explained in the previous Office Action.

Applicant has not presented any arguments specifically traversing this rejection but instead relies upon the traversal discussed above. Therefore, this rejection is maintained for the reasons presented above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

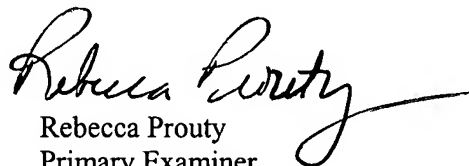
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca E. Prouty whose telephone number is 571-272-0937. The examiner can normally be reached on Tuesday-Friday from 8 AM to 5 PM. The examiner can also be reached on alternate Mondays



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Rebecca Prouty', with a long horizontal flourish extending to the right.

Rebecca Prouty  
Primary Examiner  
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